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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,621	10/07/2005	Adrian Charlton	P70855US0	9152
136	7590	09/11/2006	EXAMINER	
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			COSIMANO, EDWARD R.	
			ART UNIT	PAPER NUMBER
			2863	

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/552,621

Applicant(s)

CHARLTON, ADRIAN

Examiner

Edward R. Cosimano

Art Unit

2863

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20050205</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. The Oath/Declaration and Abstract as originally filed are acceptable to the examiner.
2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
3. The sheets of drawings filed on 07 October 2005 containing figures 1 & 2 are acceptable to the examiner.

4. The disclosure is objected to because of the following informalities:

A) the disclosure lacks a statement of -I claim:--, as required by Office policy as set forth in MPEP 608.01(m).

- 4.1 Appropriate correction is required.

5. How Claims are to be interpreted during the prosecution of an application for patent.

5.1 The pending claims are interpreted by giving the language of every positively recited limitation of the pending claims the broadest reasonable interpretation that is consistent with how one of ordinary skill at the time of the invention would have interpreted the language of the claims, In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999), while (1) taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification, In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997), and (2) without reading unrecited limitations from applicant's disclosure in to the claims, see In re PRATER AND WEI, 162 USPQ 541 at 551 (CCPA 1969) "We are not persuaded by any sound reason why, at any time before the patent is granted, an applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim.", In re PRATER AND WEI, 162 USPQ 541 at 551 (CCPA 1969).

5.1.1 Further, when interpreting the claims as a whole, then the interactions of claim limitations as a whole must be considered in order to determine the scope of a claim and the applicant's contribution in the art, In re LARSEN, No. 01-1092 (Fed. Cir. May 9, 2001) (unpublished) "The court observed that the totality of all the limitations of the claim and their interaction with each other must be considered to ascertain the inventor's contribution to the art.". Where a statutory process/machine must contain an operative series of acts/functions or structures, In re MUSGRAVE, 167 USPQ 280 at 289-290 (CCPA 1970), with explicitly recite all of the necessary interactions to accomplish the recited utility of the claimed invention, for

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without these interaction the claim as a whole would not be a proper process/machine under the statute, In re SARKAR 200 USPQ 132 at 136 (CCPA 1978).

5.1.2 In regard to the limitations on the interpretation of the claimed invention as imposed by the Court, it is noted that applicant has gone to great lengths in the written description to describe each of the disclosed means or acts by not describing a specific structure for each of means or a specific act but by describing the means or act by describing the function of each of the means or acts. Hence, it is noted that as set forth by the Court each of the limitations of the claims could be reasonably interpreted by one of ordinary skill at the time of the invention as not being not limited to the corresponding disclosed structure/act but in fact would to be broadly interpreted to include any and all means/structures that would provide the corresponding functions or acts that are recited as the claimed invention.

6. Claims 1-20 are objected to because of the following informalities.

6.1 Claims 1 & 18 are incomplete because, as recited in these claims, these claims are directed to a process (claim 1) and a machine (claim 18) for “facilitating the identification, authentication or quality control of packaged products”, and the final step/function that is recited in this claims performs a comparison by “comparing the results of the said analysis with the recorded readings within predetermined tolerance limits.”. While the results of the final comparison may have utility in many potential applications/uses, these claims fail to recite that the results of the recited comparison are in fact used to achieve the desired utility of either (a) the identification of packaged products; or (b) the authentication of packaged products; or (c) the quality control of packaged products. Because the recited comparison is not recited with in the claim as being associated with one or more of the recited desired utilities of the claimed invention one of ordinary skill at the time of the invention could not ascertain whether or not (A) additional steps would be required to achieve ay one or more of the recited desired utilities; or (B) that applicant intends the recited comparison to achieve one or more of the recited desired utilities, In re Larsen, No. 01-1092 (Fed. Cir. May 9, 2001) (unpublished) “The court observed that the totality of all the limitations of the claim and their interaction with each other must be considered to ascertain the inventor’s contribution to the art. Upon review of the claim in its entirety, the court concluded that the claim at issue apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112 paragraph 2.”.

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6.2 Claims 16 & 17 are confusing since these claims which are drafted as dependent claims appear to an invention that is different from the inventions recited in the base claim 1. In this regard, as can be seen in claim 1, claim 1 is directed to “A method for facilitating the identification, authentication or quality control of packaged products, which methodology comprises”, whereas:

A) claim 16 which as drafted appears to be dependent from claim 1 but as recited in the preamble appears to be directed “A marking method to facilitate the identification authentication or quality control of packaged products, comprising” in which a step of claim 1 is performed independently; and

B) claim 17 that as drafted appears to be dependent from claim 1 but as recited in the preamble appears to be directed “An authentication method for the identification, authentication or quality control of packaged products comprising” in which a step of claim 1 is performed independently.

Since the invention recited in claims 16 & 17 does not appear to be directed to the same invention that is recited in claim 1, these claims may be interpreted as independent claims that make an attempt to incorporate a step recited in claim 1. Hence it is unclear whether applicant intends claims 16 & 17 to be independent or dependent claims.

6.3 In regard to claims 16 & 17, both of these claims recite the performance of a step “independently”, however it is unclear with respect to what recited step is the respective step to be performed independently.

6.4 To resolve these issues regarding claims 16 & 17, it is suggested that claims 16 & 17 be amended as follows:

Claim 16 (currently amended): “A ~~marking method in accordance with claim 1 to facilitate the identification authentication or quality control of packaged products~~, comprising the marking phase ~~in accordance with claim 1~~ being performed independently of the authentication phase.

Claim 17 (currently amended): An ~~authentication method in accordance with claim 1 for the identification, authentication or quality control of packaged products~~ comprising the authentication phase ~~in accordance with claim 1~~ being performed independently of the marking phase.

6.5 Appropriate correction is required.

7. The following is a statement of reasons for the indication of allowable subject matter:

A) however, the prior art does not fairly teach or suggest in regard to claims 1-21:

A) and in particular claims 1-20 a process (claims 1-17) and a machine (claims 18-20) in which the composition of a substance is converted into machine readable data that is applied/marked to the container of the substance and at a subsequent time a sample of the substance is taken and analyzed and compared to the read marked information to see if the substance is similar within tolerances limits to the originally analyzed substance.

B) a manufacture in which the composition of a substance is converted into machine readable data that is applied/marked to the container of the substance.

8. The examiner has cited prior art of interest, for example:

A) Pelavin (2,960,910) discloses a process/machine in which the amount of light transmitted through a substance is measured to determine the quantity of various constituents of the substance and then the results are recorded as a graph.

B) Martens et al (3,428,796) discloses a process/machine in which the amount of light transmitted/absorbed by a substance is measured to determine the concentration of various constituents of the substance.

C) Markant et al (3,537,820) discloses a process/machine in which properties of a substance are measured and correlated to determine the various constituents of the substance.

D) Varnela (3,547,541) discloses a process/machine in which the amount of light transmitted/absorbed by a substance at various frequencies is measured to determine the various constituents of the substance.

E) Cox (EP 0244094 A2) discloses the process in which the results of chemical tests that cause a change in color are recorded using a color coding system in which the test results recorded by indicating a corresponding color on a chart.

F) Adler et al (DE 4436923 C1) discloses a process/machine in which a spectrum analysis of a substance is used to generate a barcode that is applied to the container of the substance by the manufacturer. Once the container of the substance has reached it's

destination the bar code is checked to determine if the container or substance has been tampered with.

G) Millot et al (FR 2787220 A1) discloses a smart electronic tag to store data/information about an item/substance that may be applied to the item or the container of the substance.

H) Kaiser et al (2002/0094058) discloses a machine/process in which taggants are added to a substance and latter detected in order to identify and verify the substance.

I) Rexhausen et al (WO 02/095651 A2) discloses comparing encoded code word in order to identify an analyte in a sample.


J) Muehl et al (2004/0024570) discloses a tag that is attached to an item and is used to store information about the item that may be retrieved and updated as necessary.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward R. Cosimano whose telephone number is 571-272-0571. The examiner can normally be reached on 571-272-0571 from 7:30am to 4:00pm (Eastern time).

9.1 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow, can be reached on 571-272-2269. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

9.2 Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ERC
09/05/2006


Edward Cosimano
Primary Examiner